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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/536,791	03/28/2000	Andrew S. Van Luchene	99-086	5835

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EXAMINER

HAMILTON, LALITA M

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/536,791

Applicant(s)

VAN LUCHENE ET AL.

Examiner

Lalita M Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/28/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification lacks support for the "proxy agreement" cited in claim 6.

On p.15, line 24 of the specification, "intermediaryif" should be "intermediary if".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected, because the "proxy agreement" is not supported in the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-5, 7-9, and 16-19 are rejected under 35 U.S.C. 102(a) as being anticipated by Buchanan (5,950,179).

Buchanan discloses a method and system of issuing a secured card for transactions comprising the steps of:

- receiving an application for a financial account and an authorization to credit a first amount to the financial account (**col.3, lines 4-11**)
- receiving information identifying a substitute collection technique (**col.1, lines**

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55-67)

- finalizing the transaction after receipt of the application and the information **(col.3, lines 24-30)**
- receiving an acceptance of an incentive offer, wherein the first amount is based on the incentive offer **(col.2, line 45 to col.3, line 5)** *(The incentive is to obtain a card for use in transactions that the customer would not ordinarily be able to obtain.)*
- establishing a second amount associated with the substitute collection technique **(col.3, lines 50-60, 65-67)** *(The second amount is the amount in the savings account.)*
- offering an incentive based on receipt of the application **(col.2, line 57 to col.3, line 5)** *(The incentive is to obtain the card to be able to make purchases with the credit card.)*
- offering an incentive based on an approval of the application **(col.2, line 57 to col.3, line 5)** *(The incentive is to obtain the card to be able to make purchases with the credit card.)*
- the substitute collection technique includes information specifying a financial account to be credited **(col.1, lines 55-67)**
- approving the application crediting the financial account by an amount equal to the first amount **(col.3, lines 24-31)**
- finalizing the transaction further comprises:
 - approving the application **(col.3, lines 24-31)**
 - crediting the financial account by an amount equal to the first amount **(col.3, lines 24-31)**
- a processor **(col.5, lines 25-28)**, a storage device coupled to said processor and storing instructions adapted to be executed by said processor **(col.5, lines 28-33)**
- a transaction database and an application database **(col.5, lines 24-33)**
- a medium storing instructions adapted to be executed by a processor to perform a method for conducting a transaction **(col.5, lines 24-33)**
- offering the seller an incentive amount **(col.3, lines 25-33)** *(The incentive amount is the advance credit card having a modest credit limit of a few hundred dollars, which is issued before a deposit is made into the savings.)*

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buchanan.

Buchanan discloses the invention substantially as claimed. Buchanan discloses a first amount that may be undetermined at the time of authorization, being that the card may be an unsecured card and the system will inform customers that the credit limit may increased upon making deposits (**col.7, lines 35-40**). It is inherent that a proxy agreement will exist given that the customer is authorizing the bank to act on their behalf. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a proxy agreement to designate the bank to act on behalf of the customer in making payments.

Claims 10,12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buchanan in view of LaLonde (5,477,040).

Buchanan discloses the invention substantially as claimed; however, Buchanan does not disclose:

- declining the application and crediting the substitute form of collection by a second amount
- crediting the substitute form of collection by a second amount if the analysis indicates a refusal of the application
- determining a second payment amount to be paid to the substitute collection technique if the first application is rejected

LaLonde teaches a method of facilitating charge transactions comprising:

- declining the application and crediting the substitute form of collection by a second amount (**col.10, lines 30-36 and 42-50**)
- crediting the substitute form of collection by a second amount if the analysis indicates a refusal of the application (**col.10, lines 30-36 and 42-50**)

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- determining a second payment amount to be paid to the substitute collection technique if the first application is rejected (**col.10, lines 30-36 and 42-50**)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to credit a substitute form of collection by a second amount, as taught by LaLonde into the device system disclosed by Buchanan, to ensure that payment may be made in case funds are not sufficient in one account.

Claims 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buchanan and LaLonde as applied to claims 10 and 12 above, and in further view of Walker (5,945,653).

Buchanan discloses and LaLonde teaches the invention substantially as claimed; however, neither reference discloses nor teaches the second amount being equal to a first amount minus an incentive amount. Walker teaches incentive amounts for charge accounts whereby the incentive amount is deducted from a first amount being charged (**col.10, lines 14-21 and 30-42**). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the second amount being equal to a first amount minus an incentive amount, as taught by Walker into the system disclosed by Buchanan and taught by LaLonde, as an additional means of getting customers to open the secured credit accounts.

Claims 14 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buchanan in view of Rosen (5,878,139) and Walker.

Buchanan discloses the invention substantially as claimed; however, Buchanan does not disclose:

- the transaction is a product return transaction

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- a method for facilitating the return of a product having a purchase price, the method comprising:
 - receiving a request to return the product
 - receiving an authorization to pay the purchase price and an incentive amount

It is inherent that a return transaction may take place when utilizing a credit or debit card, since purchasers are sometimes unhappy with their purchases for a variety of reasons. Rosen teaches a method of electronic merchandise dispute resolution comprising a product return transaction and receiving a request to return the product (**col.29, lines 34-50**). Walker teaches incentive amounts for charge accounts whereby the incentive amount and purchase amounts are paid (**col.10, lines 14-21 and 30-42**). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the process of receiving a request to return a product, as taught by Rosen, and receiving an authorization to pay the purchase price and incentive amount, as taught by Walker into the system disclosed by Buchanan, to demonstrate that return transactions are well known and to provide an additional incentive to entice customers to open secured accounts.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M Hamilton whose telephone number is (703) 306-5715. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-

2272.

A handwritten signature in black ink, appearing to be 'LMH' with a stylized flourish.

LMH

A handwritten signature in black ink, appearing to be 'Hani M. Kazimi' with a stylized flourish.

**HANI M. KAZIMI
PRIMARY EXAMINER**